

REMARKS

This paper is being submitted in response to the Final Office Action (“Action”) mailed on August 6, 2009. Claims 3-9 are pending. Claims 3-9 are rejected. Applicant respectfully requests reconsideration of claims 3-9 in view of the foregoing amendments and the following remarks.

I. AMENDMENT TO SPECIFICATION

Paragraph 15 of the specification was previously amended in the response of April 15, 2008. However a subsequent amendment on April 1, 2009 inadvertently was based on the original text and therefore omitted the April 2008 amendment. The amended paragraph now submitted herein shows the contributions of both previous amendments and also corrects a grammar error by replacing “Referred now also to FIG. 2” with “Referring now to FIG. 2.”

II. CLAIM REJECTIONS

35 USC § 103 (a) Rejections

Claims 3-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Gelardi et al (US 2003/0106814) in view of Petermann (DE 20008218). Applicant respectfully traverses the rejection.

In responding to Applicants’ prior response, the Examiner cites *In re Keller* and *In re Merck*, stating that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. However, in considering a §103(a) rejection, the question is whether there is any reason why the references could or would be combined. Just because a combination is possible does not mean that any motivation is present to make the combination. The unsuitability of an individual reference or its apparent irrelevance to the problem

to be solved are pertinent to whether the combination would have been obvious.

The Gelardi '814 reference suggests in paragraph 43 that additional panels may be added to the jacket, but the additional panels shown are not narrow regions near the spine, but are approximately the same size as the original front and rear panels, as shown in Figure 10 of the '814 reference. Furthermore, although Gelardi '814 realizes that package design may result in less strain on the package, his paragraph 46, sentence 3 suggests "First, depending on how the package is used, the location of the hinge away from the spine of the jacket may result in less strain on the package as it is unfolded" (emphasis added). This statement is made in the context of FIG. 11, which shows the hinge located remotely from the spine – at the other end of the front or rear panel. Thus the Gelardi '814 reference would reduce strain by moving the hinge away from the spine. This teaches away from Applicant's design where less strain is provided while keeping the hinge proximate to the spine.

Petermann does not appear to teach or suggest any relationship between the "3 mm broad region" and reducing stress on the book structure, while Gelardi '814 teaches moving the hinge away from the spine to reduce stress. Since Gelardi '814 has a route to reduce stress, in a manner different from Applicant, and since Petermann does not appear to be concerned with stress, therefore, one of ordinary skill in the art would not be motivated to combine the "3 mm broad region" of Petermann with the structure of Gelardi '814 for any purpose, and particularly for reducing stresses. At least for the forgoing reasons, Applicant respectfully requests the 103(a) rejection of claims 3-9 to be reconsidered and withdrawn.

CONCLUSION

All remaining claims are believed to be in condition for allowance, and an early notice thereof is respectfully requested. Should the Examiner determine that additional issues exist which might be resolved by a telephone conference, they are respectfully invited to contact the Applicant's undersigned representative.

The Director is hereby authorized to charge any additional fees or underpayments of fees under 37 C.F.R. §§ 1.16 and 1.17, or to credit any overpayments, to Deposit Account Number 13-2500. Applicant is a large entity.

Respectfully Submitted,

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